REMARKS

The present application includes pending claims 16, 17 and 20-31, all of which have been rejected. The Applicants respectfully submit that the claims define patentable subject matter.

Claims 16-17, 20, 22-23 and 25-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,497,502 ("Castille") in view of United States Patent No. 4,949,187 ("Cohen") and United States Patent No. 6,601,159 (the "Smith patent"). Claim 27 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Castille in view of Cohen, the Smith patent and United States Patent No. 4,667,802 ("Verduin"). Claims 28-31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Castille in view of the Smith patent. The Applicants respectfully traverse these rejections for at least the following reasons:

Initially, the Applicants note that the Smith patent forms the basis for rejecting all of the pending claims of the present application with respect to 35 U.S.C. § 103. The Smith patent is a continuation of United States Application No. 08/435,125, filed May 5, 1995 (the "Smith '125 CIP"), which is a continuation-in-part of United States Application No. 07/815,217, filed December 31, 1991 (the "Smith '217 application"). *See* Smith at column 1, lines 5-8. As discussed above, the '302 patent, from which the present application claims priority, was filed March 6, 1992. The filing date of the '302 patent antedates the Smith '125 CIP, but is after the Smith '217 application. Thus, in order to establish a *prima facie* case of obviousness, the Office

Action needs to show that the Smith '217 application, in combination with the other cited references, discloses all of the relevant limitations of the rejected claims.

The Office Action acknowledges that "Castille does not disclose... compressing and decompressing song data or a user attract mode wherein song associated images are shown." *See* September 21, 2007 Office Action at pages 6, 9, 11 and 12-14. In order to overcome this deficiency, the Office Action relies on the Smith patent as disclosing these limitations. *See id.* In particular, the Office Action cites the Smith patent at column 7, lines 63-66, as disclosing "compressing and decompressing video and audio data" and an "attract mode." *See id.* ("Smith teaches compressing and decompressing video and audio data to more efficiently use available storage capacity and an attract mode, see column 7, lines 63-66, to increase machine usage.").

The Smith patent "relates generally to an improved user interface for an electrophotographic reproduction machine, commonly referred to as a 'photocopier' or, more simply, a 'copier,' as well as multifunction devices." *See* the Smith patent at column 1, lines 11-15. Indeed, the Smith patent "provides an integrated information support system for a **copier machine**." *See id.* at column 4, lines 6-7 (emphasis added).

The portion of the Smith patent relied on by the Office Action states the following:

> Among the types of information which may be provided to a system user spontaneously by the integrated information support system are "special frames," such as graphics displayed during idle time, run time and warmup.

See the Smith patent at column 7, lines 63-66. Thus, the Smith patent discloses that "graphics" may be displayed during idle time, run time and warmup.

As noted above, the Office Action acknowledges that "Castille **does not disclose**... compressing and decompressing **song data or a user attract mode wherein song associated images are shown**." Moreover, there is nothing in the cited portion of the Smith patent that describes, teaches or suggests "compressing and decompressing **song data** or a **user attract mode** wherein **song associated images are shown**." *See* September 21, 2007 Office Action at pages 6, 9, 11, 12 and 13-14. *See* September 21, 2007 Office Action at pages 6, 9, 11, 12 and 13-14. Instead, as noted above, the Smith patent merely discloses that graphics may be displayed during idle time, run time and warmup **of a photocopier**. The Smith patent, furthermore, does not describe that these graphics are designed to attract users. As noted below with respect to the Smith '217 application, these graphics seemingly indicate that the system is idle, running or warming up. Additionally, there is nothing in the Smith patent that describes that such graphics are associated with songs.

As noted above, the Office Action acknowledges that "Castille **does not disclose**... compressing and decompressing **song data or a user attract mode wherein song associated images are shown**." *See* September 21, 2007 Office Action at pages 6, 9, 11 and 12-14. Further, the portions of the Smith patent relied on by the Office Action merely disclose that graphics may be shown during idle time, run time and warmup of a copier, but do not describe

these graphics as anything related to a user attract mode, and clearly do not describe that the graphics are associated with songs. Thus, because none of the cited references describes, teaches or suggests these limitations, the combination of the references, by definition, cannot describe, teach or suggest these limitations. That is, the proposed combination of references does not describe, teach or suggest the following:

- "instructions causing the processor, **when no song is playing** on the computer jukebox, to generate a **user attract mode** wherein digitally-stored **song associated graphic images** are decompressed and shown on the display," as recited in independent claim 16;
- "instructions causing the processor, **when no song is playing** on the computer jukebox, to generate **a user attract mode**," as recited in independent claim 22;
- "instructions causing the processor, when **no song is playing** on the computer jukebox, to generate a **user attract mode**," as recited in independent claim 27;
- "instructions causing the processor, **when no selected song is playing** on the computer jukebox, to generate a **user attract mode** in which the song associated images are decompressed and shown in the display," as recited in independent claim 28;
- "wherein said processor generates a **user attract mode** in which digitally-stored **song associated graphics** are decompressed and shown on said display when **no selected song is playing** on the computer jukebox," as recited in independent claim 29; or

- "generating a **user attract mode** in which digitally-stored song associated graphics are decompressed and shown on a display when **no selected song** is playing on the computer jukebox," as recited in independent claim 30.

Thus, for at least these reasons, the proposed combination of Castille, Cohen and Smith patent does not render the pending claims unpatentable.

Additionally, the Applicants acknowledge that the portion of the Smith patent relied on by the Office Action is recited in the Smith '125 CIP. *See* the Smith '125 CIP at page 12, lines 11-16. Thus, the Smith patent provides support for this cited portion as of May 5, 1995, which is over three years after the filing date of the '302 patent.

The Smith '217 application does not, however, recite this passage from the Smith patent that is relied on by the Office Action. Further, the Smith '217 application is the only application within the Smith chain of priority that antedates the filing date of the '302 patent, which is in the priority chain of the present application.

The current Office Action cites, however, the Smith '217 application at page 5, lines 11-14 and page 9, lines 20-27 as supporting the Smith patent. The Smith '217 application at page 5, lines 11-14 discloses, however, the following:

> The compact disc (not shown), which is loaded into the CD ROM device 3 is capable of storing compressed and uncompressed video frame, audio, and text data.

This portion of the Smith '217 application merely discloses that a CD may store compressed and uncompressed video frame, audio and text data, but does not describe, teach or suggest "wherein said processor generates a **user attract mode** in which digitally-stored **song associated graphics** are decompressed and shown on said display when **no selected song is playing** on the computer jukebox," as recited in independent claim 29, or "generating a **user attract mode** in which digitally-stored song associated graphics are decompressed and shown on a display when **no selected song** is playing on the computer jukebox," as recited in independent claim 30.

Further, the Smith '217 application at page 9, lines 20-27 recites the following:

> Many of the standard features performed by known user interfaces are included in the integrated information support system of the present invention. Special frames are provided, such as idle time or warmup display. Also, special frame can include a listing of supplies in the copier (e.g., toner and paper) and support for administrative tasks, such as an indication of copier usage.

This portion of the Smith '217 application merely discloses that the copier may display "special frames" related to idle time or warmup display. Neither this, nor any other portion of the Smith '217 application, indicates that such "idle time" and "warmup" "special frames" are directed to attracting users to a jukebox. Indeed, this portion of the Smith '217 application indicates that the special frames merely indicate "idle time" or "warmup."

Neither Castille, Cohen, nor the Smith patent and '217 application describe, teach or suggest "wherein said processor generates a **user attract mode** in which digitally-stored **song**

associated graphics are decompressed and shown on said display when **no selected song is playing** on the computer jukebox," as recited in independent claim 29, or "generating a **user attract mode** in which digitally-stored song associated graphics are decompressed and shown on a display when **no selected song** is playing on the computer jukebox," as recited in independent claim 30. The Applicants respectfully submit that the Office Action has not established that the Smith patent qualifies as prior art with respect to the limitations discussed above. Indeed, the proposed combination of references does not describe, teach or suggest the limitations noted above. For at least these reasons, the Applicants respectfully request reconsideration of the 35 U.S.C. § 103 rejections.

In general, the Office Action makes various statements regarding the pending claims and the cited references that are now moot in light of the above. Thus, the Applicants will not address such statements at the present time. The Applicants expressly reserve the right, however, to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness with respect to any of the pending claims for at least the reasons discussed above and request that the outstanding rejections be reconsidered and withdrawn. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney for Applicants.

The Commissioner is authorized to charge any necessary fees, including the fee for the extension of time in which to respond, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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